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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,153	08/21/2003	Jeong-Kyu Moon	678-1123 (P10535)	8920

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EXAMINER
DESIR, PIERRE LOUIS

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/646,153	MOON, JEONG-KYU	
	Examiner	Art Unit	
	Pierre-Louis Desir	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 09/18/2006 have been fully considered but they are not persuasive.

Applicants argue, regarding claims 4 and 8, that in the combination of Nonami and Moran, there is never a situation where a call is not established.

Examiner respectfully disagrees with Applicants while referring Applicants to the Response received by the Patent Office on 02/23/2006. In that response (part of the prosecution), Applicants disclosed, "in the combination of Nonami and Moran, if a call is not established and a message is to be sent to the called mobile terminal, the telephone number (or other identification of the called terminal) would need to be reentered after attempting the call and before sending the message." Thus, Applicants admit that in the combination of Moran and Nonami there is a situation where a call is not established.

As stated in the previous Office Action, as known in the art, before a message is transmitted to a destination party, information regarding the destination party, such as information that identified the destination party (i.e., phone number) must be known. The claims, broadly read, "...if the call connection between the mobile terminal and the counterpart mobile terminal is not established, pressing a one touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message to the counterpart mobile terminal." Nonami discloses a portable phone comprising of a P key serving as "one-touch" dialing key for an instant originating of call to already registered phone numbers, and SEND key serving as transmitting/receiving key. Nonami further disclosed

that upon a transmission operation (SEND key), the formed message is then transmitted from the antenna. Thus, one skilled in the art would undoubtedly conceptualize that the pressing of the end key characterizes the attempt to establish a call connection (see col. 2, lines 4-8; col. 6, lines 1-5). Moran discloses a method (with the service of voice mail or answering services, which would present that the destination party's unavailability to receive the call; therefore, the call is diverted to voice mail or answering services) wherein a user is able to send a pre-recorded message by pressing a particular function key on a telephone handset (see abstract).

Also, Examiner respectfully reminds Applicant that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the combined teachings of the references read on the claim

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nonami, U.S. Patent No. 6647258 in view of Moran, Pub. No. US 2002/0073142.

Regarding claim 4, Nonami discloses a method for performing a one-touch call operation using a mobile terminal, comprising the step of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal (i.e., Nonami discloses a portable phone comprising of a P key serving as "one-touch" dialing key for an instant originating of call to already registered phone numbers, and SEND key serving as transmitting/receiving key. Nonami further disclosed that upon a transmission operation (SEND key), the formed message is then transmitted from the antenna. Thus, one skilled in the art would undoubtedly conceptualize that the pressing of the end key characterizes the attempt to establish a call connection) (see col. 2, lines 4-8; col. 6, lines 1-5).

Although, Nonami discloses a method wherein information entered during the attempt to establish the call connection is used to transmit a message (see col. 2, lines 4-8; col. 6, lines 1-5), Nonami does not specifically disclose a method comprising the step of: if the call connection between the mobile terminal and the counterpart mobile terminal is not established, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message to the counterpart mobile terminal.

However, Moran discloses a method (with the service of voice mail or answering services, which would present that the destination party's unavailability to receive the call; therefore, the call is diverted to voice mail or answering services) wherein a user is able to send a pre-recorded message by pressing a particular function key on a telephone handset (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to facilitate the sending of messages to the destination party.

Regarding claims 5-7, Nonami discloses a method as described above (see claim 4 rejection).

Although Nonami discloses a method as described, Nonami does not specifically disclose wherein the step pressing the one-touch call button of the mobile terminal, includes the steps of: reading out a phone number of the mobile terminal and the predetermined message from a memory of the mobile terminal; and simultaneously transmitting the phone number of the mobile terminal and the predetermined message to the counterpart mobile terminal.

However, Moran discloses a method wherein a messaging server is arranged to store one or more pre-specified messages, wherein the pre-specified message can be a standard message containing the originator's details (i.e., phone number, name) and a request to be called back. Moran further discloses the step of receiving an input from a user, indicating that the pre-specified message is to be sent to the destination party, and sending the pre-specified message to the destination party mailbox (see page 1, paragraphs 8-12). Nonami further discloses, as related to claim 6 and 7, a method wherein the predetermined message is a previously voice message or text message (i.e., pre-recorded voice or text message) (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art to combine both arts to arrive at the claimed invention. A motivation for doing so would have been to provide a messaging system, which overcomes the tedious routine of repeating one's name, phone number, and time of call (see paragraph 3).

Regarding claims 8-10, Nonami discloses a method for performing a one-touch call operation using a mobile terminal, comprising the step of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal (i.e., Nonami discloses a portable phone comprising of a P key serving as "one-touch" dialing key for an instant originating of call to already registered phone numbers, and SEND key serving as transmitting/receiving key. Nonami further disclosed that upon a transmission operation (SEND key), the formed message is then transmitted from the antenna. Thus, one skilled in the art would undoubtedly conceptualize that the pressing of the end key characterizes the attempt to establish a call connection) (see col. 2, lines 4-8; col. 6, lines 1-5).

Although, Nonami discloses a method wherein information entered during the attempt to establish the call connection is used to transmit a message (see col. 2, lines 4-8; col. 6, lines 1-5), Nonami does not specifically disclose a method comprising the steps of: if the call connection between the mobile terminal and the counterpart mobile terminal is not established, pressing a one-touch call button of the mobile terminal; and transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message to the counterpart mobile terminal.

However, Moran discloses a method (with the service of voice mail or answering services, which would present that the destination party's unavailability to receive the call; therefore, the call is diverted to voice mail or answering services) wherein a user is able to send a pre-recorded message by pressing a particular function key on a telephone handset (see abstract). Moran further discloses the step of transmitting a phone number of the mobile terminal and a predetermined message to the counterpart mobile terminal (i.e., a messaging server is arranged to

store one or more pre-specified messages, wherein the pre-specified message can be a standard message containing the originator's details (i.e., phone number, name) and a request to be called back. Moran further discloses the step of receiving an input from a user, indicating that the pre-specified message is to be sent to the destination party, and sending the pre-specified message to the destination party mailbox) (see page 1, paragraphs 8-12). And as related to claims 9-10, Moran further discloses a method wherein the predetermined message is a previously voice message or text message (i.e., pre-recorded voice or text message) (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art to combine both arts to arrive at the claimed invention. A motivation for doing so would have been to provide a messaging system, which overcomes the tedious routine of repeating one's name, phone number, and time of call (see paragraph 3).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-7799. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pierre-Louis Desir
11/16/2006

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER